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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WILLIS, MICHAEL A

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 02/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/759,165

Applicant(s)

DOUIN ET AL.

Examiner

Michael A. Willis

Art Unit

1617

--Th MAILING DATE of this communication appears on th cover sheet with the correspond nc address --

THE REPLY FILED 21 January 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-3, 18, 25, 28, 38, 39 and 43-58Claim(s) withdrawn from consideration: 4-17, 19-24, 26, 27, 29-37, 40-42 and 59-69

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

  
SREENI PADMANABHAN  
PRIMARY EXAMINER

  
Michael A. Willis  
Patent Examiner

Continuation of 5. does NOT place the application in condition for allowance because: Claims 1-3, 18, 25, 28, 38-39, and 43-58 are rejected under 35 USC 103(a) as being unpatentable over Janchipraponvej (US Pat. 4,954,335) in view of Sweger et al (US Pat. 5,482,704) and Martino et al (US Pat. 6,210,689) for reasons as stated previously.

Applicant argues that Sweger does not provide the requisite motivation to substitute CEPA-starch for Carbopol thickeners in the compositions of Janchipraponvej. For example, Applicant argues that the lotion compositions of Example II of Sweger are entirely different than the hair conditioners of '335. Further, applicant argues that Sweger fails to identify how CEPA-starch would be expected to perform in compositions other than those of Example II. The argument is not convincing in that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F. 2d 413, 208 USPQ 871 (CCPA 1981). In the instant case, the conclusions of Sweger that CEPA-starch is "actually superior to the Carbopol standard" (col. 9, lines 2-3) would have suggested to one of ordinary skill in the art the desirability of substituting CEPA-starch for Carbopol as thickeners or emulsion stabilizers in cosmetic treatments.

Applicant argues that combining the teachings of '335 with the teachings of Sweger by substituting CEPA-starch for carbopol would render the compositions of '335 unsatisfactory for their intended purpose. For example, Applicant argues that '335 discloses "clear hair-treating" compositions. Applicant argues that '335 lists suitable thickeners and does not mention CEPA-starch. The fact that '335 does not mention CEPA-starch is not convincing that CEPA-starch is unsuitable, but may merely reflect the fact that '335 was published in 1990 while Sweger was published in 1996. Applicant asserts that modified starches such as CEPA-starch are not known for their clarity in aqueous solutions. While Applicant argues that a certain reference suggests that starch can impart opacity in cosmetic compositions, it is noted that Applicant did not submit the reference in an IDS, and as such the reference is not considered. Additionally, Applicant's assertions do not take the place of a Declaration to the effect that CEPA-starch would render the compositions of '335 unsatisfactory for their intended purpose.

Applicant argues that combining the teachings of '335 with the teachings of Martino would render the compositions unsatisfactory for their intended purpose. For example, Applicant argues that '335 teaches that while anionic surfactants effectively clean the hair, they also leave the hair in a cosmetically-unsatisfactory condition thereby requiring the conditioning compositions taught by '335. Therefore, applicant argues that one of ordinary skill would not be motivated by '335 to include the anionic surfactants of Martino. The examiner concedes that '335 lacks the motivation to add the anionic surfactants of Martino. However, the motivation to add the surfactants of Martino is found in Martino. Martino teaches compositions to provide conditioning and aesthetic properties which contain amphoteric polysaccharide derivatives (see col. 2, lines 12-28). The compositions are specifically for conditioning keratin substances. Further, Martino teaches that surfactants such as alkyl ether sulfates are well known for their use in cosmetic compositions (see col. 5, lines 10-15). Applicant argues that cationic compounds have the ability to complex with anionic surfactants to form water-insoluble complexes that would result in compositions that are not clear, as required by '335. However, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F. 2d 413, 208 USPQ 871 (CCPA 1981). In the instant case, Martino teaches that alkyl ether sulfates are well known for their use in cosmetic compositions. Absent a showing of unexpected results or a Declaration to the effect that alkyl ether sulfates are incompatible with the disclosure of '335, applicant's assertions are not convincing.